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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,812	11/08/2002	Bradley William Caprathc	BFA-007.01	5075
959	7590	01/09/2004	EXAMINER	
LAHIVE & COCKFIELD, LLP.			CELSA, BENNETT M	
28 STATE STREET			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	

1639

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.

09/674,812

Applicant(s)

CAPRATHE ET AL.

Examiner

Bennett Celsa

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION / *Election/Restriction*

Claims 1-35 are currently pending.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1. In order for all inventions to be searched, the appropriate additional search fees must be paid.

Group 1, claim(s)1-19(IN PART), drawn to FORMULA I compounds in which Y is an Asp derivative,X is hydrogen; and 1st method of use in treating stroke.

Group 2, claim(s)1-19(IN PART), drawn to FORMULA I compounds in which Y is an Asp derivative,X is an (un)substituted aryl group substituted aminosulfoxide(two structures on page 94, lines 15 and 20); and 1st method of use in treating stroke.

Group 3, claim(s)1-19(IN PART), drawn to FORMULA I compounds in which Y is an Asp derivative,X is dimethyl cyclohexyl(one) substituted aminosulfoxide (3 structures on pages 94-95); and 1st method of use in treating stroke.

Group 4, claim(s)1-19(IN PART), drawn to FORMULA I compounds in which Y is an Asp derivative,X is a dimethylcyclopentanone substituted aminosulfoxide (second structure on page 95); and 1st method of use in treating stroke.

Group 5, claim(s)1-19(IN PART), drawn to FORMULA I compounds in which Y is an Asp derivative,X is (un)substituted aryl group substituted alkylsulfinyl (fourth and fifth structures on page 95); and 1st method of use in treating stroke.

Group 6, claim(s)1-19(IN PART), drawn to FORMULA I compounds in which Y is an Asp derivative,X is the fifth structure on page 95; and 1st method of use in treating stroke.

Group 7, claim(s)1-19(IN PART), drawn to FORMULA I compounds in which Y is an Asp derivative,X is sixth structure on page 95; and 1st method of use in treating stroke.

Group 8, claim(s) 1-5 (IN PART) and 8-19 (IN PART), drawn to FORMULA I compound in which Y is a succinimyl derivative (second Y structure on page 93) and 1st method of use in treating stroke.

Group 9, claim(s) 1-5 (IN PART) and 8-19 (IN PART), drawn to FORMULA I compound in which Y is a cyano derivative (third Y structure on page 93); and 1st method of use in treating stroke.

Groups 10-18 claim (s) 20-23, drawn to second method of using a compound of one of Groups 1 to 9 above to treat inflammation.

Groups 19-27 claim(s) 24-25, drawn to third method of using a compound of one of Groups 1-9 above to treat septic shock.

Groups 28-36, claim(s) 26-27, drawn to fourth method of using a compound of one of Groups 1-9 above to treat reperfusion injury.

Groups 37-45, claim(s) 28-29, drawn to fifth method of using a compound of one of Groups 1-9 above to treat Alzheimers.

Groups 46-54, claim(s) 30-31, drawn to sixth method of using a compound of one of Groups 1-9 above to treat shigelolosis.

Group 55-63, claim(s) 32-33, drawn to seventh method of using a compound of one of Groups 1-9 above to treat multiple sclerosis.

Group 64-72, claim(s) 34-35, drawn to eighth method of using a compound of one of Groups 1-9 above to inhibit ICE.

1. The inventions listed as Groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: .

The inventions listed as Groups 1-9 do not relate to a single inventive concept under PCT Rule 13.1 and 13.2 because these compounds lack the same or corresponding special technical features for the following reasons: The Group 1-9 compounds lack a significant structural element (e.g. core) which is shared by all of the alternatives which elicits a common activity nor do the different alternatives represent a recognized class of chemical compounds so as as to constitute a proper Markush group. Further, the lack of any significant core structure shared by Groups 1-9 precludes the ability to conduct a meaningful search. Groups 10-72 represent further

methods of use which represent different and diverse diseases or conditions which require different etiologies and fail to share a special technical feature. It is also noted that pursuant to Rule 13, a compound is only entitled to be linked to a single method of use, with additional methods constituting additional groups.

ELECTION OF SPECIES (Groups 1-72 above)

Upon selection of any of the above groups (compounds or use thereof), the following election of species is required.

The independent claims are generic to a plurality of disclosed patentably distinct species comprising succinimide derivative compounds which differ in chemical structure, which require different and separately burdensome manual/computer structure and bibliographic searches in patent/literature databases.

Applicant is required under 35 U.S.C. 121 to **elect a single disclosed species**, even though this requirement is traversed. A **chemical structure representing the elected compound should be provided** if not present in the specification in order to facilitate a search.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

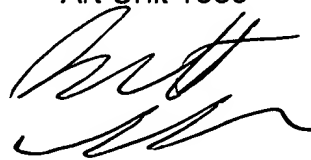
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Celsa whose telephone number is 703-305-7556. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Bennett Celsa
Primary Examiner
Art Unit 1639



11/18/03

BC